



Atty. Dkt. No. 025098-0701

H32
Plunkett
5/24/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BAIRD et al.
Title: DESIGN, SYNTHESIS AND USE OF SPECIFIC
POLYAMIDE DNA-BINDING LIGANDS
Appl. No.: 09/372,474
Filing Date: 08/11/1999
Examiner: A. Marschel
Art Unit: 1631

TERMINAL DISCLAIMER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Your Petitioner, California Institute of Technology, having its principal place of business at 1200 E. California Blvd., Pasadena, CA 92115 (hereinafter "CIT") represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 09/372,474, filed August 11, 1999, which claims priority to PCT/US98/01714 filed January 29, 1998 and which is a continuation-in-part of International Application number PCT/US97/03332, filed 02/20/1997, Serial No. 08/853,522 filed May 8, 1997, and International application number PCT/US97/12722 filed July 21, 1997 which are continuation-in-part applications of Serial No. 08/837,524, filed April 21, 1997, Serial No. 08/607,078, filed February 26, 1996, claiming the benefit of provisional application Serial No. 60/042,022 filed April 16, 1997 and provisional application Serial No. 60/043,444 filed April 8, 1997, by virtue of an Assignment filed 05/12/2003 TPLUNKET 00000001 500072 09372474 and recorded on 08/11/1999, on Reel/Frame 010167/0912, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A. 01 FC:2814 55.00 CH

Further, your Petitioner represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 09/414,611, filed October 8, 1999, now United States Patent No. 6,506,906 issued January 14, 2003, which is a continuation of International Application Number: PCT/US98/06997, filed on Apr. 8, 1998, which is a continuation-in-part of application No. PCT/US97/12722, filed on July 21, 1997, and a continuation-in-part of application No. 08/853,522, filed on May 8, 1997, and a continuation-in-part of application No. PCT/US97/03332 filed Feb. 20, 1997, each is a continuation-in-part of application No. 08/837,524, filed on April 21, 1997, and a continuation-in-part of application No. 08/607,078, filed on Feb. 26, 1996, and claims the benefit of U.S. provisional application 60/042,002, filed on April 16, 1997, and U.S. provisional application No. 60/043,446, filed on April 8, 1997, and U.S. Provisional application 60/043,444 filed Apr. 8, 1997, by virtue of an Assignment recorded on January 10, 2002, on Reel/Frame 012476/0137, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX B.

Your Petitioner, California Institute of Technology, hereby disclaims the terminal part of the term of any patent granted on the above identified patent application which would extend beyond the full statutory term, as shortened by any terminal disclaimer of U.S. Patent 6,506,906, and hereby agrees that any patent so granted on the above identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent 6,506,906 shall be the same as the legal title to any patent granted on the above identified patent application, this agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent 6,506,906 as defined in 35 U.S.C. §§154-156 and 173, in the event that U.S. Patent 6,506,906 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of U.S. Patent 6,506,906 as defined in 35 USC §§154-156 and 173, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent 6,506,906, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioner, certifies that he has reviewed the Assignment documents attached as APPENDICES A and B, and to the best of his knowledge and belief, legal title to the above identified patent application and U.S. Patent 6,506,906 rests with Petitioner, California Institute of Technology.

The undersigned declares that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be

true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Date May 2, 2003

Respectfully submitted,

FOLEY & LARDNER

Customer Number: 23620

23620

23620

PATENT TRADEMARK OFFICE

Telephone: (858) 847-6700

Facsimile: (858) 792-6773

By Richard San Pietro

Richard San Pietro

Attorney for Applicant

Registration No. 45,071

For Richard J. Warburg